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ISIS-0710

**PETITION TO
WITHDRAW FROM ISSUE
UNDER 37 CFR 1.313(c)(1)****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Cook et al.

Serial No.: 07/967,267

Group Art Unit: 1623


Filed: October 27, 1992

Examiner: Howard Owens

For: Oligonucleotides Containing 2'-O-Modified Purines

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JUL 19 2005

OFFICE OF PETITIONS**CERTIFICATE OF FACSIMILE TRANSMISSION**DATE OF DEPOSIT: July 19, 2005I HEREBY CERTIFY THAT THIS PAPER IS BEING
FACSIMILE TRANSMITTED TO THE PATENT AND
TRADEMARK OFFICE TO FACSIMILE NUMBER 571-273-
0025 ON THE DATE LISTED ABOVE.
TYPED NAME: Jeffrey H. Rosedale
REGISTRATION NO.: 46,018Office of Petitions
MAILSTOP 313C
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO WITHDRAW FROM ISSUE UNDER 37 C.F.R. § 1.313(c)(1)

Applicants respectfully request that the above-identified patent application be withdrawn from issue after payment of the issue fee, pursuant to 37 C.F.R. § 1.313(c)(1). This petition is being accompanied with:

- a) an unequivocal statement that one or more claims are unpatentable;
- b) an amendment to such claim or claims;
- c) an explanation as to how the amendment causes such claim or claims to be patentable;
- d) a showing of good and sufficient reasons why withdrawal of the application from issue is necessary; and
- e) the fee set forth in 37 CFR 1.17(h), large entity, for this petition.

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Unequivocal Statement that One or More Claims are Unpatentable

Applicants respectfully submit that allowed claims 9 and 20 are unpatentable under 35 U.S.C. §102(b) in view of Inoue, *et al.*, "Studies on the recognition mode of *E.coli* RNase H using modified oligonucleotide probes", *Nucleic Acids Research*, 1988, Symposium Series No. 20, 9-10 ("the Inoue reference"). A copy of the Inoue reference and an Information Disclosure Statement directed to it accompany this petition.

Amendment to the Claims

Enclosed herewith is a new listing of allowed claims 9, 10, and 15-27 showing amendments to claims 9 and 20.

Explanation as to How the Amendment Causes Claims 1 and 20 to be Patentable

The Inoue reference, page 10, discloses oligonucleotides containing guanine-based nucleotides modified with 2'-O-methoxymethyl groups (compounds V and VI containing Gm' groups). In claims 1 and 20, as amended, R₁ does not include 2'-O-methoxymethyl groups.

Showing of Good and Sufficient Reasons Why Withdrawal of the Application from Issue is Necessary

Although the issue fee was paid September 18, 2003, Applicants only recently became aware of the Inoue reference. Withdrawal of the application from issue is necessary because allowed claims 1 and 20 are unpatentable under 35 U.S.C. §102(b) in view of the Inoue reference for the reasons described above.

Fee Set Forth in 37 CFR 1.17(h) for this Petition

Please charge the \$130.00 fee to Deposit Account # 23-3050.

Applicants respectfully request granting of this petition, consideration of the Information Disclosure Statement, entering of the amendment, and a prompt notice of allowance. Please charge any additional fees or deposit any refunds to Deposit Account # 23-3050.

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If there are any questions or concerns, the office is urgently requested to telephone Applicant's attorney at the number listed below.

Respectfully submitted,



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